

REMARKS/ARGUMENTS

The Office Action mailed August 23, 2006 has been carefully reviewed. Reconsideration of this application, as amended and in view of the following remarks, is respectfully requested. The claims presented for examination are: claims 1-35.

35 USC §102 Rejection

In the Office Action mailed August 23, 2006, pages 2-5, claims 1-4, 6, 8-11, 16-26, 28, and 30-35 were rejected under 35 USC §102(b) as being anticipated by the Linden et al reference (US Patent No. 5,634,936).

Applicants have amended the claims believe the invention claimed in the amended claims is not anticipated by the Linden et al reference. The standard for a 35 USC §102 rejection is stated in RCA Corp. v. Applied Digital Systems, Inc. 221PQ 385, 388 (d. Cir. 1984) "Anticipation is established only when a single prior art reference discloses, either expressly or under principles of inherency, each and every element of a claimed invention."

Applicant points out that the following elements and steps of Applicants' amended claims are not found in the Linden et al reference:

"said closure body made of a shape memory polymer (SMP),
said shape memory polymer (SMP) being formed into a primary shape,
compressed into a reduced secondary stable shape, then controllably
actuated so that it recovers its primary shape," or

"wherein said shape memory polymer (SMP) provides said closure body
with said reduced secondary stable shape configured for positioning said
closure body within said lumen, and said primary shape configured to
close said anomaly," or

"providing a closure body made of a shape memory polymer (SMP), said
shape memory polymer (SMP) capable of being formed into a primary

shape, compressed into a reduced secondary stable shape, then controllably actuated so that it recovers its primary shape," or

"positioning said closure body made of a shape memory polymer (SMP) in the passage of the physical anomaly when said closure body is disposed in said reduced secondary stable shape," or

"transitioning said closure body made of a shape memory polymer (SMP) to said primary shape within the passage, thereby closing said anomaly," or

"said shape memory polymer (SMP comprises a shape memory polymer foam having at least one hard segment and one soft segment wherein said hard segment is formed at a temperature above T_{trans} and said soft segment is formed at a temperature below T_{trans} ."

Since the elements steps described above are not found in the Linden et al reference, the Linden et al reference does not support a 35 USC §102(b) rejection of Applicants' amended claims and the rejection should be withdrawn.

35 USC §103 Rejections

In the Office Action mailed August 23, 2006, page 6, claims 12-15 and 25 were rejected under 35 USC §102(b) as being unpatentable over the Linden et al reference (US Patent No. 5,634,936) in view of the Michlitsch reference (US 2006/0155330). Applicants have amended the claims and believe the invention claimed in the amended claims is patentable over the Linden et al and Michlitsch references.

In the Office Action mailed August 23, 2006, pages 6-7, claims 5, 7, 27, and 259 were rejected under 35 USC §102(b) as being unpatentable over the Linden et al reference (US Patent No. 5,634,936) in view of the Li reference (US 5,571,181). Applicants have amended the claims and believe the invention claimed in the amended claims is patentable over the Linden et al and Li references.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966) that are applied for establishing a background for determining obviousness under 35 USC §103(a) include “Ascertaining the differences between the prior art and the claims at issue.”

The differences between the Linden, Michlitsch, and Li references and Applicants’ invention includes the fact that the following elements and steps are not found in the Linden, Michlitsch, and Li references:

“said closure body made of a shape memory polymer (SMP), said shape memory polymer (SMP) being formed into a primary shape, compressed into a reduced secondary stable shape, then controllably actuated so that it recovers its primary shape,” or

“wherein said shape memory polymer (SMP) provides said closure body with said reduced secondary stable shape configured for positioning said closure body within said lumen, and said primary shape configured to close said anomaly,” or

“providing a closure body made of a shape memory polymer (SMP), said shape memory polymer (SMP) capable of being formed into a primary shape, compressed into a reduced secondary stable shape, then controllably actuated so that it recovers its primary shape,” or

“positioning said closure body made of a shape memory polymer (SMP) in the passage of the physical anomaly when said closure body is disposed in said reduced secondary stable shape,” or

“transitioning said closure body made of a shape memory polymer (SMP) to said primary shape within the passage, thereby closing said anomaly,” or

“said shape memory polymer (SMP) comprises a shape memory polymer foam having at least one hard segment and one soft segment wherein said hard segment is formed at a temperature above T_{trans} and said soft segment is formed at a temperature below T_{trans} .”

Since the Linden, Michlitsch, and Li references lacks the above identified elements and steps and there is not a showing or suggestion of Applicants’ claim

elements or steps, a 35 USC §103(a) rejection of Applicant's claims is not be appropriate and the rejection should be withdrawn.

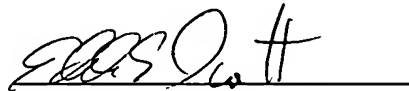
The Linden et al Reference

The Linden et al reference discloses "hardenable polymeric materials" (See Col.2, line 21, of the Linden et al reference). The Linden et al reference "hardenable polymeric materials" are very different from Applicants' claimed "shape memory polymer (SMP) being formed into a primary shape, compressed into a reduced secondary stable shape, then controllably actuated so that it recovers its primary shape." Since the Linden reference lacks applicants' claimed "shape memory polymer (SMP) being formed into a primary shape, compressed into a reduced secondary stable shape, then controllably actuated so that it recovers its primary shape" the rejection of Applicants' amended claims is inappropriate and should be withdrawn.

SUMMARY

The undersigned respectfully submits that, in view of the foregoing amendments and the foregoing remarks, the rejections of the claims raised in the Office Action dated August 23, 2006 have been fully addressed and overcome, and the present application is believed to be in condition for allowance. It is respectfully requested that this application be reconsidered, that the claims be allowed, and that this case be passed to issue. If it is believed that a telephone conversation would expedite the prosecution of the present application, or clarify matters with regard to its allowance, the Examiner is invited to call the undersigned attorney at (925) 424-6897.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "Eddie E. Scott", is written over a horizontal line.

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